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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,654	10/06/2000	David Allison Bennett	PSTM0015/MRK	9943

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/680,654

Applicant(s)

BENNETT ET AL.

Examiner

Jamisia A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) 22-25, 52-55 and 70-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 26-51 and 56-69 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6.7.10.11.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-69 are, drawn to a method of interactively displaying shipping rates, classified in class 705, subclass 1.
 - II. Claims 70-89, drawn to method of regeneration of shipping info based on updated input fields, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operations and different effects. Invention II is based on a method of interactively displays shipping rates, it does not in any way deal with updating fields and regenerating information, Invention II does not require the use of interactive displays.
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to the following patentably distinct species of the claimed invention: If Invention 1 above is chosen then one of the following species must be elected.

a. Species a: Claims 8-12 and 39-42 are drawn to an independent and distinct species.

b. Species b: Claims 22-25 and 52-55 are drawn to another independent and distinct species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1-7, 13-21, 26-38, 43-51, and 56-69 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Marilyn Korshandi on March 18, 2004 a provisional election was made without traverse to prosecute the invention of Group I and Species A, claims 1-21, 26-51 and 56-69 . Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-25, 52-55 and 70-89 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

7. The declarations filed with the Information Disclosure Statement #7, filed 8/22/01, are not considered to be proper IDS references. They have been reviewed and considered and placed in the file, however are not considered to be a "reference cited".

Specification

8. The use of the trademarks UPS, USPS, FedEx, Mailboxes Etc., and Airborne Express have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

9. The claims contain two claim # 42s, for examination purposes the examiner is naming the first claim 42 as 42a, and the second as 42b. The applicant is required to number claims sequentially in numeric format, therefore the applicant must renumber the second claim 42 as claim 43, and renumber all claims following. See MPEP 37 CFR 1.126 for claim numbering rules.

Double Patenting

10. Claims 10 and 41 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 9 and 40. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-21, 26-51, and 56-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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13. With respect to Claims 1, 32, and 62 the phrase “each of a plurality of users” is indefinite. It is unclear as to each what, of a plurality of users. Is this “each user of a plurality of users”? It is unclear to the examiner what the word “each” is referring to, therefore it is unclear what or who the display is displayed to.

14. With respect to Claims 3 and 34 the phrase “each of said cells” is indefinite. Previously it was claimed an array of a plurality of cells, therefore it is unclear what this phrase is referring to. Is “each cell of a plurality of cells”? It is unclear to the examiner what the word “each” is referring to, therefore it is unclear what is actually being displayed.

15. With respect to Claims 4-6, 14, 19, 26, 28, 29, 30, 31, 35-37, 44, 49, 56, 58-61, 64, and 66-69: these claims are written as one long run-on sentence, and therefore it is unclear what is actually being positively claimed and what is just a descriptive part of the claim. The examiner suggest the use of commas to separate the actual claimed features.

16. Claims 5 and 36 recites the limitation "said sub-cell divisions" in line 5. There is insufficient antecedent basis for this limitation in the claim. Previously in the claim it recited a “plurality of sub-cell division.

17. With respect to Claims 17 and 47 the phrase “each of the plurality of displayed delivery dates” is indefinite. It is unclear as to each what, of a plurality of delivery dates. Is this “each delivery date of the plurality of delivery dates”? It is unclear to the examiner what the word “each” is referring to.

18. With respect to Claims 21 and 51: These Claims already state that the second axis is dedicated to time, therefore it is unclear how the axis can be two different variables. A lack of prior art rejection in these claims does not indicate that the claims are allowable.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-7, 13-21, 26-38, 41-51, and 56-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. The basis of this rejection is set forth in a two-prong test of:

- a. whether the invention is within the technological arts; and
- b. whether the invention produces a useful, concrete, and tangible result.

4. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e. the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts. In the present case, Claims 1-7, 13-21, 26-38, 41-51, and 56-61 only recites an abstract idea. The recited steps of merely displaying an online interactive graphic for comparison of rates and calculating rates based on delivery time and date does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. Even though the claim recites the user accessing a computer system, the these steps only constitute an idea of how to apply these rules to choose one carrier over another,

they do not require the use of the computer system to do them. And even though there is an online interactive graphic, the claims never specifically state any steps of collecting any information or manipulation of any data.

5. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is a positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps require anything in the technological arts, as explained above. Looking at the claim as a whole, nothing in the body of the claim recites any structure of functionality to suggest that a computer performs the recited steps. Therefore the preamble is taken to merely recite a field of use.

6. Additionally for a claimed invention to be statutory, the claimed invention must produce a useful, concrete and tangible result. In the present case, the claimed invention produces calculated rates for carriers used in selecting a specific service for shipping (i.e., useful and tangible).

7. Although the recited process produces a useful, concrete and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, Claims 1-7, 13-21, 26-38, 41-51, and 56-61 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. Claims 1, 2, 13, 14, 32, 33, 43, 44, 62, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara (6,233,568) in view of UPS® Service Guide (www.ups.com) and FedEx® Services (www.fedex.com).

22. With respect to Claims 1, 2, 13, 14, 32, 33, 43, 44, 62 and 63: Kara discloses an onscreen interactive display with a selection and comparison section for a plurality of carriers with a plurality of services (See Figure 8). However Kara does not specifically disclose the rates being calculated with respect to time. Both UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the time sensitive “urgency” services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1).

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23. Claims 3-12, 15-20, 26-31, 34-42, 45-50, and 56-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara, UPS®, and FedEx® as applied to claims 1, 2, 32, 33 and 62 above, and further in view of Barnett et al. (6,369,840).

24. With respect to Claims 3, 4, 15-19, 26-28, 34, 35, 45-49, 56-58, 64-66: Kara, UPS® and FedEx® above disclose a calculation of rates with respect to special services, which include date and time sensitive services. However fails to disclose a graph with one axis being date and one axis being time and where each cell is located at the intersection of the date and time. Barnett discloses the use of a calendar which can be used for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to display the calculation of shipping rates, calculated by Kara, UPS® and FedEx®, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2).

25. With respect to Claims 5 and 36: Barnett discloses subdividing each cell with the plurality of services (See Figures 12 and 13).

26. With respect to Claims 7 and 38: Barnett discloses the display can be checked (See Figures 8 and 9 with corresponding brief descriptions), and therefore the examiner considers this to be a selection button.

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27. With respect to Claims 6, 20, 37 and 50: Kara and Barnett above discloses the claimed invention, but fails to disclose the use of colorizing the display. It is old and well known in the art that colorizing a display so distinguish one service or one carrier from another. This is done in legends on a map, or a legend in a bar graph, where each bar is colorized to represent a specific group of data. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to colorize the display so that each carrier has a different color, due to the fact that this technique is old and well known in the art.

28. With respect to Claims 8-12, 29-31 and 39-42(a & b), 59-61, 67-69: Kara and Barnett disclose the use of the interactive display but fails to disclose when the cursor is placed on the cell it displays details of the specific service (in this instance details of the carrier and service). It is old and well known in the art that when a selection or service that is available, when a cursor is placed over the selection a detailed popup window is displayed and once the service is clicked on it is started up. This is done in the Microsoft® Windows™ environment. When a cursor is placed over a file a more detailed description of the file is popped up, and once the file is clicked on, the file is opened up or the program is started. This is done in the taskbar that is located at the bottom of the monitor. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a pop up window giving details of the carrier service and then once the cell is clicked the service is selected, due to the fact that this feature is old and well known in the art to display more detailed information upon selection.

29. With respect to Claims 9, 10, 12, 31, 40, 41, 42b, 61 and 69: Kara discloses once the service is selected a shipping layer with respect to the carrier is displayed (See Figure 9).

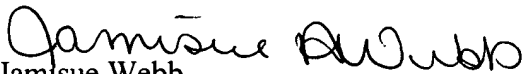
Conclusion

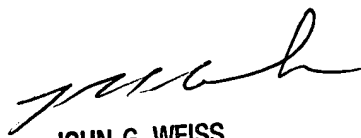
30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mandt (6,621,532) discloses the use of dropdown menus and pop up menus, Huemoeller et al. (5,855,006) discloses the use of a weekly calendar system, Hogan et al. (5,414,809) discloses the use of graphical displays, Nicholls et al. (5,485,369) discloses the use of a carrier selection system, Boucher et al. (6,078,889) discloses the use of a carrier manager librarian, Barni et al. (6,064,981) discloses the use of an online negotiation of carrier rates, and Hisbani et al (EP 0943904) discloses calculated rates being based on the class of service provided for shipping.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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